

ATTORNEY'S DOCKET NO. L0461/7078

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Old et al.
Serial No. : 09/462,929
Conf. No. : 5664
Filed : July 15, 1998
For : CANCER ASSOCIATED NUCLEIC ACIDS AND POLYPEPTIDES
Examiner : B. Sisson
Art Unit : 1634

CERTIFICATE OF FACSIMILE TRANSMISSION 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being facsimile transmitted to the United States Patent and Trademark Office in accordance with 37 C.F.R. §1.6(d) to the attention of Examiner Bradley L. Sisson, Art Unit 1634, in Technology Center 1600 of the Patent and Trademark Office, Washington, D.C. 20231, FAX number 703-872-9306, on the 26th day of June, 2002.


Monica E. Zombori

Commissioner for Patents
Washington, D.C. 20231

Sir:

AMENDMENT

This is responsive to the Office Action mailed on February 28, 2002. Please amend the above-identified application as follows.

In the Claims

Please amend the claims as follows. Applicants have included herewith a page showing the markups of the claims with insertions and deletions indicated by underlining and bracketing, respectively.

- C¹
- 67.(amended) An isolated nucleic acid molecule selected from the group consisting of
- (a) a nucleic acid molecule comprising a fragment of SEQ ID NO:681 of at least 8 nucleotides,
 - (b) complements of (a).

Serial No. 09/462,929

- 2 -

Art Unit 1634

C₂ 118.(amended) The isolated nucleic acid molecule of claim 67, which codes for a polypeptide which, or a portion of which, binds an MHC molecule to form a complex recognized by a an autologous antibody or lymphocyte.

121.(amended) An expression vector comprising the nucleic acid molecule of claim 67 operably linked to a promoter.

C₃ 122.(amended) A host cell transformed or transfected with an expression vector of claim 121.

✓ Please add the following new claims:]

C₄ 124. An isolated nucleic acid molecule comprising a nucleotide sequence selected from the group consisting of (a) SEQ ID NO:681, (b) nucleotide sequences which hybridize under stringent conditions to a nucleic acid molecule consisting of SEQ ID NO:681 and which code for a cancer associated antigen precursor, (c) nucleic acid molecules that differ from the nucleic acid molecules of (a) in codon sequence due to the degeneracy of the genetic code, and (d) complements of (a), (b), or (c).

125.(new) An expression vector comprising the isolated nucleic acid molecule of claim 124 operably linked to a promoter.

126.(new) A host cell transformed or transfected with an expression vector of claim 125.

Remarks

The Examiner has withdrawn from consideration several claims that Applicants believe are properly considered with claim 67 as elected. Claims 71, 74, 75, 83, and 118-123 all relate to the same subject matter, i.e., fragments of specific nucleic acid molecules. Claims 118-120 correspond to claims 68-70, each of which depends from claim 67. Although the Examiner considered that there was no special technical feature in common between certain of the claims,

L00461_70078 FIRST AMENDMENT1

Serial No. 09/462,929

- 3 -

Art Unit 1634

Applicants respectfully request reconsideration in view of the amendments made herein. In particular, claims that depend from claim 67 should be grouped together with claim 67, as should claims that share the technical feature of the particular nucleotide sequence of SEQ ID NO:681. Accordingly, Applicants respectfully urge the Examiner to reconsider the withdrawal from consideration of these claims, and to reinstate the claims for examination.

Applicants have amended certain of these claims, and respectfully request that the examiner consider the claims as amended. Claims 67, 118, 121, and 122 have been amended. Claims 124-126 were added. All of the claims presented are believed to pertain to nucleic acid molecules sharing the technical feature of a particular nucleotide sequence, SEQ ID NO:681. No new matter has been added.

Rejection Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claim 67 as lacking an adequate written description. Applicants have amended claim 67 and added new claims pertaining to related subject matter. In addition, Applicants respectfully request that other claims, withdrawn from consideration by the Examiner, be reinstated for examination.

As amended, Applicants believe that one of ordinary skill in the art would recognize that Applicants were in possession of the claimed invention. Applicants respectfully request reconsideration of the rejection of claim 67 under 35 U.S.C. § 112, first paragraph.

Rejection Under 35 U.S.C. §§ 101 and 112, First Paragraph

The Examiner rejected claim 67 as lacking a specific utility or a well-established utility. Applicants have amended claim 67 to clarify the claim, and as a result, Applicants believe that the claim clearly has a specific, credible and well-established utility as a nucleic acid molecule. Moreover, one of ordinary skill in the art would know how to make and use the invention as now claimed. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 67 under 35 U.S.C. §§ 101 and 112, first paragraph.

Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claim 67 as indefinite. Applicants have amended claim 67 to clarify the claim, and as a result, Applicants believe that the claim is not indefinite as it clearly

L00461_70078 FIRST AMENDMENT1

Serial No. 09/462,929

- 4 -

Art Unit 1634

does not recite a method step. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 67 under 35 U.S.C. § 112, second paragraph.

Rejection Under 35 U.S.C. § 102

The Examiner rejected claim 67 as anticipated by the Promega catalog, specifically random hexanucleotide primers described therein. Applicants have amended claim 67 and respectfully request reconsideration.

As presently amended, claim 67 recites a fragment of SEQ ID NO:681 of at least 8 nucleotides. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 67 under 35 U.S.C. § 102.

Respectfully submitted,



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